

REMARKS

In the Office Action dated December 17, 2003, claims 1 and 3-24 were rejected. Claim 12 stands rejected under 35 U.S.C. §112, second paragraph. Claims 1, 3-9, 12, 15, 19-21, and 24 also stand rejected under 35 U.S.C. §103 over U.S. Patent No. 5,061,481 to Suzuki et al. ("Suzuki '481") in view of U.S. Patent No. 4,970,252 to Sakuta et. al ("Sakuta '252"). Claims 1, 8, 9, 12, 20-21 and 24 stand rejected under 35 U.S.C. §103 over U.S. Patent No. 5,496,554 to Mellul et. al ("Mellul '544") in view of the Sakuta '252. Claims 1,8, 10, 11 and 20-24 stand rejected under 35 U.S.C. §103 over U.S. Patent No. 6,436,413 B1 to Gers-Barlag et al. ("Gers-Barlag '413) in view of the Sakuta '252. Claims 1 and 15-18 stand rejected under 35 U.S.C. §103 over U.S. Patent No. 6,503,519 to Sakuta ("Sakuta '519") in view of the Sakuta '252 patent. Finally, claims 1, 3, 13 and 14 stand rejected under 35 U.S.C. §103 over U.S. Patent No. 6,395,857 B1 to Suzuki et. al ("Suzuki '857") in view of the Sakuta '252 patent.

In response, Applicants have amended claims 1 and 12, and have added claim 25. These amendments when considered with the remarks set forth below are deemed to place the application in condition for allowance. Claims 1 and 3-25 remain pending for continued examination. Claim 1 has been amended only to improve syntax and the scope of the claim 1 remains unaltered. Withdrawal of the rejection of claims 1 and 3-24, and allowance of claim 25, is respectfully requested.

Rejection under 35 U.S.C. §112, Second Paragraph

Claim 12 stands rejected for indefiniteness as reciting a broad claim as to cosmetics incorporating trimethylsiloxysilicate and dimethylsiloxo while also reciting

narrower statements of the aforementioned groups as MQ and MDQ resins. See Office Action at page 2.

In response, Applicants have amended claim 12 so as to remove the recitations of the narrower groups of MQ and MDQ resins. The deleted subject matter is now found in new claim 25. Applicants respectfully submit that this amendment cures the rejection made by the Examiner. Therefore, withdrawal of the rejection is respectfully requested.

Rejection of Claims 1, 3-9, 12, 15, 19-21 and 24 under 35 U.S.C. §103

Claims 1, 3-9, 12, 15, 19-21, and 24 stand rejected as obvious over Suzuki '481 in view of the Sakuta '252. The Examiner states that it would be obvious for one of ordinary skill in the art to use the low-viscosity silicon oil disclosed in the Sakuta '252 (i.e., methyltris(trimethylsiloxy)silane ("M3T")) as found in Example 6) in the cosmetic composition of Suzuki '481. The Examiner rationale for this assertion is that Sakuta '252 teaches it is known to use M3T in cosmetic compositions. Alternatively, the Examiner contends that it is *prima facie* obvious to combine two compounds taught in the prior art for use for the same purpose.

Applicants respectively traverse this rejection since Examiner characterization of M3T as found in example 6 of Sakuta '252 is a bit erroneous. Contrary to the Examiner contention, M3T (taught as low-viscosity silicone oil (D) in the Sakuta '252) is not a component of the disclosed cosmetic composition but merely a reaction solvent (i.e., diluent) for the addition polymerization process used to prepare the cosmetic product. *See e.g.*, Sakuta '252 at column 5, lines 9-19. Thereafter, the polymerization

product (i.e., polymer) swells in the presence of the low-viscosity silicone oil (D). *See* column 5, lines 57-63 (which refers to the polymerization product as component (I)) . However, the low-viscosity silicone oil (D) is then displaced from the polymerization product (i.e., component 1) by swelling the polymerization product with a saturated hydrocarbon oil, which is referred to as component (II), in order to obtain a transparent oily paste as a final product. *See* Column 5, line 65 – column 6, line 6. Thus, it will be clear to one skilled in the art that the cosmetic end-product (an oily, transparent paste) does not contain M3T as alleged by the Examiner.

Turning to example 6, it is clear from a reading of the specification that M3T is only being used as a diluent in the polymerization reaction and is not a component of the cosmetic end-product. Example 6, at column 9, lines 34-44, recites the description on the preparation of the polymerization product (i.e., component (I) as previously described in the specification:

The procedure of Example 1 was repeated to obtain a polymerization product, except that the charged materials were replaced with 320 g of dimethylhydrogensilyl-terminated dimethylpolysiloxane (average molecular weight: 2,870; Si--H: 2.5 mol %), 616 g of trimethylsilyl-terminated dimethylvinylpolysiloxane (average molecular weight: 5,000; vinyl group content: 1.5 mol %) and 1,405 g of methyltris(trimethylsiloxy)silane (viscosity: 1.6 cBt). and 0.5 g of a 2 % chloroplatinic acid solution in isopropanol.

While this intermediate polymerization product is not described physically in example 6, example 1 does provide a physical description of the intermediate polymerization product. Example 1 describes the intermediate polymerization product as “[a] white and soft powder. . . .” *See* Sakuta ‘252 at column 7, lines 28-29. Thus, from the

description set forth in the examples, this product is not the cosmetic product alluded to by the Examiner.

At column 9, lines 44-52, example 6 then continues on to describe the addition of a saturated hydrocarbon (i.e., component (II) as described in the specification) to eventually obtain the end-product, which is a colorless and transparent composition:

In the same manner as in Example 1, an oily paste composition was prepared, except that 100 parts by weight of this polymerization product and 300 parts by weight of a saturated hydrocarbon oil ("Isozole 300"; boiling temperature range: 170 to 189.degree. C. product by Nippon Petrochemical Co., Ltd.) were mixed.

This composition had a colorless and transparent appearance, and had a viscosity of 150,000 cP.

From this description of example 6, it is clear that M3T is not a component of the cosmetic product. As a result, Applicants do not see how one skilled in the art would be motivated to use the M3T diluent of Sakuta '252 as a component of the cosmetic of Suzuki '481. There is nothing in Sakuta '252 that would motivate one skilled in the art to use M3T as a cosmetic component as taught in Suzuki '481. Withdrawal of the rejection is therefore respectfully requested.

Moreover, even assuming arguendo that there was motivation to combine the references, the cited prior art still does not teach or suggest the improved properties of a cosmetic achieved through the use of M3T as compared to other low-viscosity silicone oils. Specifically, Applicants have found that M3T offers improvements in performance over other low-viscosity silicone oils that is not taught or suggested by the cited prior art. The Examiner's attention is respectfully directed to example 1 and

comparative example 1 of the present specification. *See* specification at pages 36-38. Example 1 and comparative example 1 differ in that the M3T used in example one was replaced with D5, which is decamethylcyclopentasiloxane. *See* specification at page 37, lines 17-20; *see also* page 2, lines 14-15. As the Examiner will note, decamethylcyclopentasiloxane is one of the preferred low-viscosity silicone oils specifically taught by Sakuta '252. *See* column 4, lines 29-31.

Based on the teachings of Sakuta '252, one skilled in the art would expect decamethylcyclopentasiloxane and M3T to be equivalents. However, as the table at the bottom of page 38 of the present specification shows, they are clearly not equivalents. As shown in the table, the inventive cosmetic composition of example 1 exhibited a durability of cosmetic coverage of 42 and a refreshing feel of 39. To the contrary, the comparative cosmetic composition of comparative example 1 exhibited a durability of cosmetic coverage of 29 and a refreshing feel of 16. Such an improvement where none is expected is indicative of unexpected results and therefore nonobviousness. Withdrawal of the above rejection is once again respectfully requested.

Rejection of Claims 1, 8, 9, 12, 20-21, and 24 under 35 U.S.C. §103

As noted above, claims 1, 8, 9, 12, 20-21 and 24 stand rejected Mellul '544 in view of the Sakuta '252. Once again, Sakuta '252 is relied upon as allegedly teaching the use of M3T as a component of a cosmetic product.

Applicants respectfully submit that this rejection also fails for the exact same reasons as the rejection over Suzuki '481 in view of the Sakuta '252. First, Sakuta '252 does not teach or suggest in any way that M3T is useful as a component for a cosmetic

product. Sakuta '252 only teaches that M3T is used as a solvent or diluent of an addition polymerization product. Thus, there is no motivation or suggestion to use M3T as a component of a cosmetic product. Second, Applicants have also found that M3T provides an unexpected improvement over the other low-viscosity silicone oils specifically taught by Sakuta '252. In fact, these other low-viscosity silicone oils (e.g., decamethylcyclopentasiloxane) are taught as preferred. An improvement where none is expected is an indicia of non-obviousness. Withdrawal of the rejection is respectfully requested.

Rejection of Claims 1,8, 10, 11, and 20-24 under 35 U.S.C. §103

Claims 1,8, 10, 11, and 20-24 stand rejected under as obvious over Gers-Barlag '413 in view of the Sakuta '252. The Examiner states that it would be obvious for one of ordinary skill in the art to combine the low-viscosity silicon oil disclosed in the Sakuta '252 patent with the emulsion disclosed in the Gers-Barlag '413.

Applicants respectively traverses this rejection since the Gers-Barlag '413 is not prior art against the present application. Applicants respectfully point out according to the "Notice of Acceptance of Application under 35 U.S.C. 371 and 37 CFR 1.494 or 1.495" mailed June 20, 2002, present application is listed as being entitled to a priority date of August 30, 1999. Gers-Barlag '413 effective U.S. filing date for 35 U.S.C. §102(e) purposes is also August 30, 1999. Thus, Gers-Barlag '413 does not pre-date the present application under 35 U.S.C. §102(e) and is not a reference. Withdrawal of the rejection is thus respectfully requested.

Rejection of Claims 1 and 15-18 under 35 U.S.C. §103

Claims 1 and 15-18 stand rejected as obvious over Sakuta '519 in view of the Sakuta '252 patent. The Examiner states that it would be obvious for one of ordinary skill in the art to combine the low-viscosity silicon oil disclosed in the Sakuta '252 with cosmetic composition disclosed in the Sakuta '519.

Applicants respectively traverse this rejection on the grounds that the Sakuta '519 is not a reference against the present application since the present application is entitled to a priority date of August 30, 1999. To the contrary, Sakuta '519 has a U.S. filing date of June 23, 2000. Thus, Applicants do not see how Sakuta '519 can be a reference against the present application. Withdrawal of the rejection is thus respectfully requested.

Rejection of Claims 1, 3, 13 and 14 under 35 U.S.C. §103

Claims 1, 3, 13 and 14 stand rejected as obvious over Suzuki '857 in view of the Sakuta '252. The Examiner states that it would be obvious for one of ordinary skill in the art to combine the low-viscosity silicon oil disclosed in the Sakuta '252 patent with the cosmetic composition claimed in the Suzuki '857 patent.

The applicant respectively traverses this rejection on the grounds that the Suzuki '857 is not a reference against the present application, which is entitled to a priority date of August 30, 1999. The effective U.S. filing date of Suzuki '857 is May 23, 2000. Thus, Applicants do not see how Suzuki '857 can be a reference against the present application. Withdrawal of the rejection is thus respectfully requested.

Applicants do not believe that any additional fees are due other than the fee for the Supplemental Information Disclosure Statement. However, if any additional fees are due, please charge such sums to our Deposit Account 50-1145.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Gerald Levy", written over a horizontal line.

Gerald Levy  
Reg. No. 24,419

Lindsay S. Adams  
Reg. No. 36,425

Attorney for Applicants

Pitney, Hardin, Kipp & Szuch LLP  
685 Third Avenue  
New York, New York 10017  
(212) 297-5800